

EXHIBIT A

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOVARTIS PHARMACEUTICALS CORPORATION,
Petitioner,

v.

REGENTS OF THE UNIVERSITY OF MICHIGAN AND
UNIVERSITY OF SOUTH FLORIDA,
Patent Owner.

IPR2023-01347
Patent 10,633,344

Before JEFFREY N. FREDMAN, MICHAEL J. FITZPATRICK, and
SHERIDAN K. SNEDDEN, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

JUDGMENT
Granting Request for Adverse Judgment After Institution of Trial
37 C.F.R. § 42.73(b)

IPR2023-01347
Patent 10,633,344

I. INTRODUCTION

Novartis Pharmaceuticals Corporation (“Petitioner”) filed a Petition requesting an *inter partes* review of claim 16 of U.S. Patent No. 10,633,344 (“the ’344 patent,” Ex. 1501). Paper 4 (“Pet.”). On March 13, 2024, we instituted an *inter partes* review as to claim 16 of the ’344 patent, the only challenged claim in this proceeding. Paper 8. On June 5, 2024, Patent Owner filed its Patent Owner Response, which states that “Patent Owner has disclaimed all interest in claim 16.” Paper 19, 1 (citing Ex. 2003). On June 6, 2024, Patent Owners filed a disclaimer of claim 16. Ex. 1592.

On July 25, 2024, counsel for Petitioner sent an email to the Board requesting entry of adverse judgment against Patent Owner pursuant to 37 C.F.R. § 42.73(b) and further stating that Patent Owner does not oppose the request. *Id.* The relevant portion of the email provides as follows:

Petitioner Novartis writes to request authorization to file a Motion for Adverse Judgment in IPR2023-01347. On June 7, 2024, Patent Owners, the Regents of the University of Michigan and University of South Florida, filed their Patent Owners’ Response, indicating they had “disclaimed all interest in claim 16,” which is the sole challenged claim in IPR2023-01347. Paper 19. Concurrently therewith, Patent Owners filed proof of the disclaimer. Exhibit 2003.

In view of the foregoing, Petitioner Novartis respectfully requests authorization to file a Motion for Adverse Judgment in IPR2023-01347. 37 C.F.R. 42.73.

Patent Owners are copied on this communication, and have indicated they do not oppose this request.

On July 31, 2024, we granted Petitioner’s request for authorization to file a motion for adverse judgment in this case via reply email. On August 6, 2024, Petitioner filed its unopposed Motion for Adverse Judgment under 37 C.F.R. § 42.73(b)(2). Paper 20 (“Mot.”).

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II. DISCUSSION

Under 37 C.F.R. § 42.73(b), “[a] party may request judgment against itself at any time during a proceeding.” While the motion for adverse judgment was initiated by Petitioner, Patent Owner does not oppose the motion and the record shows that Patent Owner has disclaimed all interest in claim 16¹ such that Patent Owner has no remaining claim in the trial, actions that are construed to be a request for adverse judgment. *Id.*

III. CONCLUSION

Having reviewed Petitioner’s unopposed Motion for Adverse Judgment, we determine that entry of judgment against Patent Owner is appropriate. Thus, we grant the request for adverse judgment pursuant to 37 C.F.R. § 42.73(b)(2). This constitutes a final written decision pursuant to 35 U.S.C. § 318(a) cancelling claim 16 of the ’344 patent.

IV. ORDER

Accordingly, it is

ORDERED that Petitioner’s Motion is granted; adverse judgment is entered against Patent Owner pursuant to 37 C.F.R. § 42.73(b)(2);

FURTHER ORDERED that claim 16 of the ’344 patent is cancelled;

FURTHER ORDERED that this constitutes a Final Written Decision under 35 U.S.C. § 318(a);

FURTHER ORDERED that Patent Owner shall file a notice and copy of this judgment in the files of any proceeding or action involving the ’344 patent; and

¹ Claim 16 is the only claim at issue in this proceeding. *See* Paper 8, 19.

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FURTHER ORDERED that, pursuant to 37 C.F.R. § 42.73(d)(3), Patent Owner is precluded from taking any action inconsistent with this judgment, including obtaining any patent claim that is not patentably distinct from cancelled claim 16 in this proceeding.

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